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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,667	02/13/2002	Modest Khovaylo	10011533-1	2675

7590 09/15/2005

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EXAMINER

JELINEK, BRIAN J

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/075,667

Applicant(s)

KHOVAYLO, MODEST

Examiner

Brian Jelinek

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Amendment

The Examiner respectfully submits a response to the amendment received on 7/5/2005 of application no. 10/075,667 filed on 2/13/2005 in which claims 1-22 are currently pending.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

The affidavit filed on 2/13/2005 under 37 CFR 1.131 has been considered but is ineffective to establish conception prior to the filing date of the application. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). In particular, the photograph labeled "Exhibit A" is of such poor quality that it fails to show possession of the invention as defined by the claims. The photograph appears to show five contraptions, each comprising a base and an arm attached to the base that suspends some type of head above the base. The Examiner alleges that the contraptions are merely reading lamps and notes that no mouse, camera, or positioning indicia are visible in the image.

Claim Objections

Claim 5 is objected to because of the following informalities: there is insufficient antecedent basis for the limitation in the claim. Claim 5 recites the limitation "said camera" in line 1 of the claim. Appropriate correction is required

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is insufficient antecedent basis for the limitation in the claim. The claim recites the limitation "the imaging pad" in line 3 of the claim. Furthermore, the third and fourth lines of the claim are nonsensical.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-5, 11-17, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Bohn (U.S. Pat. No. 6,525,306).

Regarding claim 1, Bohn discloses an imaging apparatus comprising a mouse pad (Fig. 1, element 20).

Regarding claim 2, Bohn teaches the mouse pad comprises an object-to-be-imaged support surface (Fig. 1, element 18) because the mouse images the planar reference object 18 when in the icon pointing mode.

Regarding claim 3, Bohn discloses the imaging apparatus further comprises a camera positioned in spaced-apart relationship with said mouse pad (Fig. 5).

Regarding claim 4, Bohn discloses the camera comprises a digital camera (Fig. 4, element 66).

Regarding claim 5, Bohn discloses a camera has an image window (Fig. 3, element 46) and wherein said mouse pad is at least coextensive with said image window (Fig. 3, 20).

Regarding claim 11, Bohn discloses a work assembly comprising: a computer (Abstract); and an optical imaging apparatus operably connected to said computer (Fig. 1); and having an object-to-be-imaged locator (Fig. 2) comprising a mouse pad (Fig. 1, element 20) because the mouse locates the object to be imaged.

Regarding claim 12, please see the rejection of claim 6.

Regarding claim 13, please see the rejection of claim 7.

Regarding claim 14, please see the rejection of claim 8.

Regarding claim 15, please see the rejection of claim 9.

Regarding claim 16, Bohn discloses an imaging apparatus comprising: means for supporting an object to be imaged (Fig. 1, element 20); means for co-acting with a

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computer mouse (Fig. 1), wherein said means for supporting comprises said means for co-acting.

Regarding claim 17, Bohn discloses a work assembly comprising: means for computing having a computer mouse operably connected thereto (Abstract); means for imaging an object (Fig. 3, element 46); and means for positioning said object relative to said imaging means and for co-acting with said mouse (Fig. 5, element 86).

Regarding claim 22, Bohn discloses a method of saving space on a desk top supporting a computer with a computer mouse and an overhead imaging device, wherein the mouse is the overhead imaging device, comprising: providing a mouse pad adapted to co-act with the mouse (Fig. 1); and using the mouse pad as an object locator for the overhead imaging device because the mouse and mouse pad comprise an object locator when operated in the icon pointing mode.

Claims 1 and 10 are are rejected under 35 U.S.C. 102(e) as being anticipated by Fukumitsu et al. (U.S. Pat. No. 6,141,052).

Regarding claim 1, Fukumitsu discloses an imaging apparatus (Fig. 2, element 18) comprising a mouse pad (Fig. 2, element 13).

Regarding claim 10, Fukumitsu discloses the mouse pad (Fig. 2, element 13) is physically attached to a base portion of said imaging apparatus (Fig. 2, element 11).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bohn (U.S. Pat. No. 6,525,306).

Regarding claim 18, Bohn teaches a method of data acquisition and processing, comprising: a mouse pad, and a mouse and integral digital camera for capturing an image of a selected object (Fig. 5). Clearly, a user would have selected any desired object for imaging with the mouse, including objects on the mouse pad. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to have placed a mouse pad in registration with the field of view of an imaging device (Fig. 5); placed an object on the mouse pad (Fig. 5); and imaged the object on the mouse pad (Fig. 5) because a user would have selected any desired object for imaging with the mouse, including objects on the mouse pad.

Regarding claim 19, Bohn discloses operating a computer mouse on the mouse pad (Fig. 1).

Regarding claim 20, Bohn discloses operating a computer mouse on the mouse pad comprises operating the mouse with the mouse pad in registration with the field of view of the imaging device (Fig. 3).

Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bohn (U.S. Pat. No. 6,525,306) in view of Dance et al. (U.S. Pat. No. 6,463,220).

Regarding claim 6, Bohn discloses a mouse pad and a mouse with an integral digital camera, wherein when the mouse is moved across the mouse pad (i.e., the planar reference object 18) an icon pointing mode is enabled, and when the mouse is lifted from the mouse pad, a camera mode is enabled for capturing an image of a selected object (Fig. 5). Bohn does not disclose the mouse pad comprises object-to-be-imaged positioning indicia.

However, Dance discloses a camera projecting a light source onto an object scene to be captured, the indicator indicating the field of view of the camera (Fig. 2, element 32). One of ordinary skill in the art would have provided the mouse and integral camera of Bohn with the field of view indicator of Dance for the purpose of indicating the field of view to be captured by the camera (col. 1, line 60-col. 2, line 5). Furthermore, it is clear that the mouse pad comprises the field of view indicators when the indicators are projected onto the mouse pad during imaging of an object on the mouse pad. As a result, it would have been obvious to one of ordinary skill in the art at the time of the invention to have provided field of view indicators projected onto the mouse pad, wherein the field of view indicators are object-to-be-imaged positioning indicia, in order to indicating the field of view to be captured by the camera.

Regarding claim 7, Dance further discloses the object-to-be-imaged positioning indicia comprises graphics (Fig. 2, element 32; col. 3, lines 12-18).

Regarding claim 8, Dance teaches indicating variable fields of view (Fig. 4) and the object-to-be-imaged positioning indicia comprises at least one peripheral edge portion of said mouse pad (Fig. 4) because the object-to-be-imaged positioning indicia comprises at least one peripheral edge portion of said mouse pad when the field of view is coincident with the mouse pad.

Regarding claim 9, Dance further discloses the positioning indicia correspond to an image window of a camera (Fig.2, element 32).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Jelinek whose telephone number is (571) 272-7366. The examiner can normally be reached on M-F 9:00 am - 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Ometz can be reached at (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Brian Jelinek
9/7/2005



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EXAMINER